

Appln. No. 10/618,867  
Amendment dated November 3, 2006  
Reply to Office Action mailed July 3, 2006

### **REMARKS**

Reconsideration is respectfully requested.

Claims 1 through 36 remain in this application. No claims have been cancelled. No claims have been withdrawn. Claims 37 and 38 have been added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

#### **Paragraphs 1 and 2 of the Office Action**

Claims 1, 14, 16 27, 28 and 31 have been rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 10 through 12 of the 6,539,973 patent.

Submitted herewith is a terminal disclaimer for the present patent application with respect to U.S. Patent No. 6,539,973, and therefore is it submitted that the judicially created doctrine of obviousness-type double patenting rejection is overcome.

Withdrawal of the double patenting rejection is respectfully requested.

#### **Paragraphs 3 and 4 of the Office Action**

Claims 1, 3, 4, 6, 7, 10 through 14, 16, 17, 19, 20, 23 through 26 and 17 have been rejected under 35 U.S.C. §102(b) as being anticipated by Goode.

Claims 2, 5, 8, 9, 15, 18, 21, 22 and 27 through 30 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Goode in view of Jernigan.

Claim 1 requires, in part, "wherein said apparatus comprises a plurality of encoded video signals, said apparatus being capable of selecting

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a specific encoded video signal for decoding and display during the transition, a subject matter of said specific encoded video signal being based upon relevance of said encoded video signal to either a subject matter of content displayed by the first video source prior to the transition or a subject matter of content selected for display via the second video source following the transition". (Claim 26 includes a similar recitation.)

It is alleged in the Office Action that:

... the claimed wherein said apparatus comprises a plurality of encoded video signals, said apparatus being capable of selecting a specific encoded video signal for decoding and display during the transition based upon said encoded video signal's relevance to either a content's subject matter displayed by the first video source prior to the transition or a content's subject matter selected for display via the second video source following the transition is met by the generating a predefined images which stores in the image memory 128 that contains a plurality of bit map images, the bit map images can be selectively display, vide clips, audio clips, animation, graphical images and the like (Fig. 1, col. 4, line 34 to col. 5, line 63).

Turning to the referenced portion of the Goode patent at col. 4, line 34 through col. 5, line 63, it appears that col. 5, lines 21 through 63 are the most pertinent, and state (emphasis added):

At step 205, the routine generates a predefined image. This image may be recalled from the image memory (128 in FIG. 1) and sets a transition timer within the decoder. As shall be described below, when the transition timer expires (times out), the routine begins a fade to the new video sequence. The predefined image can be a bit map image, but is more typically, a previously received and decoded sequence of MPEG encoded packets. In the preferred embodiment of the invention, the CPU instructs the MPEG decoder to "freeze" the image that is presently being displayed. Thus, the predefined image is all or a portion of a frozen last frame of video.

At step 206, the routine begins fading the presently displayed video image into the predefined image. In addition, the presently playing audio is also faded to a predefined audio signal, e.g., no sound. Typically, if predefined audio is desired, the predefined audio compliments or is, in some manner, associated with the predefined image stored in the image memory. Preferably, the predefined image is a white background containing a centrally located geometric shape or object. The object is generally designed to distract the user or the

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customer from observing the latency during command implementation.  
The predefined image is not required to be static and, for example, can be a video clip, animation segment, a series of static images and the like.

In the preferred embodiment, the frozen image contains a centrally located object that is common to the beginning and ending frames of all video images displayed by the system. To facilitate a transition from one video segment to another, the OSD function of the MPEG decoder is used to "fade" all or part of the frozen image to white. However, the centrally located object is not faded. The fade is accomplished by designating the entire screen except for the object as an OSD graphic region and then fading the graphic overlay from transparent to opaque. The centrally located object is keyed or otherwise associated with the previous video segment and is also keyed or associated with the upcoming video segment. As such, this object is contained in the beginning and ending sequence of all displayed video and the viewer experiences a spacial continuity from video segment to video segment.

However, it is submitted that nothing here describes or leads one of ordinary skill in the art to the requirement of claim 1 that "a subject matter of said specific encoded video signal being based upon relevance of said encoded video signal to either a subject matter of content displayed by the first video source prior to the transition or a subject matter of content selected for display via the second video source following the transition". The Goode patent instead discusses a predefined image that "is preferably a white background containing a centrally located geometric shape or object... designed to distract the user... from observing the latency".

It is submitted that one of ordinary skill in the art, considering this portion of the Goode patent, would recognize that there is no "capab[ility] of selecting a specific encoded video signal... based upon relevance of said encoded video signal to either a subject matter of content displayed by the first video source prior to the transition or a subject matter of content selected for display via the second video source following the transition". Instead, the Goode system employs the same "predefined image" at each transition that doesn't necessarily have any relationship to the video fading out and the video fading in, except for the frozen image fading out. There

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is no apparent indication that the predefined image is different between different transitions, and indeed Goode states that the "object [of the predefined image] is contained in the beginning and ending sequence *of all displayed video* and the viewer experiences a spacial continuity from video segment to video segment" (emphasis added). It is submitted that one of ordinary skill in the art thus would not understand that the Goode patent is disclosing "said apparatus comprises a plurality of encoded video signals". Thus, one of ordinary skill in the art is left with the definite impression that there is no "apparatus being capable of selecting a specific encoded video signal for decoding and display during the transition", as the predefined image never changes, especially based upon the subject matter of the content of the first or second video source. In fact, the Goode patent stresses the continuity of showing the same "predefined image" at each transition.

It is therefore submitted that one of ordinary skill in the art would not be led to the requirements of claim 1 by the Goode patent.

Further, claim 7 requires "an alternate means for decoding an encoded video signal into a decoded video signal wherein said overlaying means overlays the decoded video signal of said alternate decoding means during the transition when said decoding means is unavailable during the transition" (claim 20 includes a similar requirement). With respect to claim 7, the Office Action states:

In consider claim 7, the claimed further comprising an alternate means for decoding an encoded video signal into a decoded video signal wherein said overlaying means overlays the decoded video signal of said alternate decoding means during the transition when said decoding means is unavailable during the transition is met by the display of such function information is generally handled by recalling a particular bit map image, overlay image, or on-screen display (OSD) graphic from the image memory for display upon the display unit during a transition period when switch from first video sequence to the second video sequence (Fig. 1, col. 3, line 54 to col. 4, line 19).

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The Goode patent at col. 3, line 54 through col. 4, line 19:

However, the back channel from the set top terminal to the server may be a separate network, e.g., the first forward channel is through a television cable network and the back channel and the second forward channel are through a telephone network. The session manager interprets the commands sent from the set top terminal through the back channel and instructs the information server to perform the command.

More particularly, the information server 102 contains at least one central processing unit 114 and, in a parallel processing computer based server, contains more than one central processing unit 114. Additionally, the server generally contains a program memory 116 that retains the programs which control the server. Some of these programs are executed in response to function requests sent from set top terminals. In addition, the CPU is connected to a data memory 118 that contains the various video and other information that is available to the customers via the system 100.

Additionally, the set top terminal 108 contains a receiver /transmitter (transceiver) 120 for receiving information from both forward channels and transmitting commands through the back channel. If the forward and back channels use a common network, the transceiver is generally operated in a frequency multiplex manner. The transceiver 120 downconverts and demodulates the signals from the network using a conventional superhetrodyne downconversion technique, a conventional QAM demodulator for the first forward channel and a conventional QPSK demodulator for the second forward channel. The first forward channel signals are generally transmitted in a standard packetized format such as the MPEG transport protocol of a transport stream. The transceiver contains a conventional MPEG transport decoder to extract particular program streams from the transport stream.

However, it is submitted that nothing here in this portion of the Goode patent discloses "wherein said overlaying means overlays the decoded video signal of said alternate decoding means during the transition *when said decoding means is unavailable during the transition*". More specifically, nothing in this portion of Goode describes any use of an alternate decoding means upon the unavailability of any decoding means. If the rejection maintained, applicant respectfully requests a more specific reference to the text of Goode where it is believed that the claimed elements are disclosed.

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With respect to claim 8, it is alleged that:

In considering claim 8, Goode et al disclose all the limitations of the instant invention as discussed in claim 1 above, except for providing the claimed said decoding means being capable of decoding an encoded commercial video signal into a decoded commercial video signal such that said overlaying means overlays the decoded commercial video signal during the transition. Jerrigan et al teach that in particular, the method comprises locally storing in said television receiver data representing commercial advertisements, selectively converting said data into video signals, and selectively switching said video signals to the display of said television receiver for a predetermined period of time (col. 1, lines 33 to col. 2, line 68). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the display commercial advertisement as taught by Jerrigan et al into Goode et al's system in order to deliver commercial advertisement to the consumer at a significantly lower cost to the advertiser.

However, the motivation suggested in the rejection merely amounts to saying that it would have been obvious to incorporate the commercials of Jerrigan into the Goode system in order to have commercials in the Goode system (without any apparent motivation in the Goode patent to lead one of ordinary skill in the art to desire commercials), and there is no support (although it is stated as being an object of Jerrigan) for the contention that the incorporation of the Jerrigan commercials into Goode would actually result in "a significant lower cost to the advertiser". It is not apparent to one of ordinary skill in the art what the "cost" is lower relative to, since there is no "cost" to advertising in the Goode system as there is no suggestion of any advertising in the Goode patent.

With respect to claim 14, which requires in part "wherein said apparatus is capable of extending the transition to a predetermined time duration when said output providing means switches from the first video source to the second video source, thereby ensuring that the decoded video signal is capable of being displayed in its entirety", the rejection of the Office Action states (emphasis added):

4) the claimed wherein said apparatus is capable of extending the

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transition to a predetermined time duration when said output providing means switches from the first video source to the second video source, thereby ensuring that the decoded video signal is capable of being displayed in its entirety is met by the setting a transition timer within the decoder (Fig. 2, col. 5, line 21 to col. 6, line 30)

However, it is submitted that the Goode patent is not clear as to whether it is the "transition timer" that governs the time between fade out of the initial video and fade in of the following video. On one hand, block 212 of Figure 2 of Goode states "WAIT FOR NEW INFORMATION STREAM UNTIL TRANSITION TIMER EXPIRES", which seems to suggest that it is the transition timer that controls the length of the transition, as well at col. 5, lines 21 through 26, where it is stated that (emphasis added):

At step 205, the routine generates a predefined image. This image may be recalled from the image memory (128 in FIG. 1) and sets a transition timer within the decoder. As shall be described below, when the transition timer expires (times out), the routine begins a fade to the new video sequence.

However, in apparent direct contrast to this is the statements in Goode at col. 6, lines 6 through 13:

At step 212, once the decoder is reset, the set top terminal awaits the new information stream while continuously displaying the predefined image. At step 214, the new information stream is received and begins to be decoded such that the set top terminal may then fade from the predefined image that is presently being displayed to imagery decoded from the new information stream.

This portion of the Goode patent clearly creates the impression that it is the arrival of the "new information stream" that controls the fade out from the transitional "predefined image".

Further, it is noted that nothing in the portions of the Goode patent cited in the rejection discloses or suggests that the Goode system is "capable of *extending* the transition", as again it is not clear whether it is the transition timer or the arrival of the new information stream that actually controls the fade in of the subsequent video.

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It is therefore submitted that the Goode patent would not lead one of ordinary skill in the art to the requirements of claim 14, particularly the requirement identified above.

Claim 27 has been amended to require, in part, "means for selecting a second decoding means if the decoding means is not available during a transition when said output providing means switches from a first video source to a second video source". Claim 31 has been amended to require "means for detecting an occurrence of a video transition from a first video source to a second video source by said output providing means", "means for determining, if an occurrence of a video transition from a first video source to a second video source is detected, if a first decoder is available", and "means for selecting a second decoder if the first decoder is not available".

It is therefore submitted that the Goode patent would not lead one of ordinary skill in the art to the applicant's claimed invention as defined in claims 1, 14, 27, and 31, especially with the requirements set forth above, and therefore it is submitted that claims 1, 14, 27, and 31 are allowable over the prior art. Further, claims 3, 4, 6, 7 and 10, which depend from claim 1 and claims 16, 17, 19, 20 and 23 through 26, which depend from claim 14 also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Withdrawal of the §102(b) and §103(a) rejections of claims 1 through 31 is therefore respectfully requested.



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**CONCLUSION**

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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